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10/002,433

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Manoel Tenorio

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i2 TECHNOLOGIES US, INC.  
ONE i2 PLACE, 11701 LUNA ROAD  
DALLAS, TX 75234

EXAMINER

THEIN, MARIA TERESA T

ART UNIT

PAPER NUMBER

3627

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/002,433 | <b>Applicant(s)</b><br>TENORIO, MANOEL |  |
|                              | <b>Examiner</b><br>MARISSA THEIN     | <b>Art Unit</b><br>3627                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claims 1-35 remain pending in this application and an action on the merits follow.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a § 101 process must (1) be tied to specific machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Claims 1-10 recite only a nominal recitation of a computer system. For example in claim 1, “the search interface” and “security module” and “intelligent module” are not positively recited. There is no mention of structure/hardware or embodiment of the interface and modules. The nominal mention of a system in the preamble is not enough.

Claims 11-22 are method steps which fail the two prongs of the test. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the

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claim should positively recite a specific machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Claim 11 again has nominal recitation of an apparatus. What apparatus is the "searching"; "decrypting" and "reissuing" done?

Thus, claims 1-22 are non-statutory.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,076,080 to Morscheck et al. in view of U.S. Patent No. 6,014,644 to Erickson.**

Regarding claims 1, 3-5, 11-13, 23-25 and 35, Morscheck discloses a system, method, and software comprising one or more repositories that stores a plurality of user document used during a first electronic commerce transaction (File menu, order log, col. 9, lines 17-20); a search interface (Order Log search criteria window, col. 10, lines 7-27); a security module that decrypts the user documents to allow a user to access the user documents (items may be disabled based on security access, col. 9, lines 21-22; col. 11, lines 36-37); and an intelligent module that updates one or more sections in the

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user documents with current information associated with a second electronic commerce transaction (change order, col. 11, lines 32-55).

However, Morscheck does not explicitly disclose a global content directory which includes a plurality of classes; the documents comprise unique documents stored in seller database (**claim 3**); classes comprise a plurality of document classes (**claims 4, 12, 24**); the classes comprise a plurality of product classes (**claims 5, 13, 25**).

Morscheck does disclose a data menu (Figure 8) which includes commands to sort and find a data and show detail of an Order Log (col. 10, lines 61-66). Morscheck discloses a filter feature wherein the Order Log entries are filtered based on specific needs. The filter feature obtains a list of log entries based on some filtering criteria. (Col. 11, lines 2-11)

Erickson, on the other hand, teaches global content directory which includes a plurality of classes; the documents comprise unique documents stored in seller database (**claim 3**); classes comprise a plurality of document classes (**claims 4, 12, 24**); the classes comprise a plurality of product classes (**claims 5, 13, 25**) (col. 7, lines 14-17; col. 7, lines 50-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made the system, method and software of Morscheck, to include global content directory which includes a plurality of classes; documents comprise unique documents stored in seller database; classes comprise a plurality of document classes; the classes comprise a plurality of product classes, as taught by

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Erickson, in order to allow easy access to the information stored (Erickson, col. 7, lines 16-17).

Regarding claims 2, 6-10, 14-21 and 26-34, Morscheck discloses the documents are stored in a shared document repository (Order Log, col. 9, lines 17-20) (**claim 2**); the security module decrypts the user section in the user documents when the user documents as permission level (col.9, lines 21-22; col. 10, lines 61-64; col. 22, lines 58-62) (**claims 6, 18, 30**); the intelligent module updates the sections in the user documents when the user requests the user documents to be updated (col. 11, lines 37-55) (**claim 7**); the search interface allows the user to view user documents after the security module decrypts the user documents but before the intelligence updates the user documents with the current information associated with an associated transaction (col. 11, lines 13-29) (**claim 8**); the intelligence module electronically creates one or more blank standard documents form the user documents (col. 15, line 65-col. 16, line 6) (**claims 9, 22 and 34**); removes information from the sections of the user documents and arranges the section in a particular order as a new document (col. 15, line 65-col. 16, line 6; col. 110, line 65-col. 111, line 13) (**claim 10**); reissuing the user document comprises automatically changing one or more sections in the document to include current information (col. 15, line 65-col. 16, line 6; col. 110, line 65-col. 111, line 13) (**claims 14, 26**); reissuing the user documents comprises determining which section of the user documents are generic and which sections are specific to a document transactions, dynamically adjusting the generic sections; determining which sections carry forward into one or more reissued user documents (col. 15, line 65-col. 16, line 6;

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col. 110, line 65-col. 111, line 13) (**claims 15-17 and 27-29**); view generic section and the transaction specific sections of the user documents (col. 11, lines 13-29) (**claims 19, 31**); searching for particular user documents' comprises navigating through the document searching for particular type of user documents (col. 11, lines 13-29) (**claims 20-21 and 32-33**).

However, Morscheck does not explicitly disclose document classes and product classes. Morscheck discloses a filter feature wherein the Order Log entries are filtered based on specific needs. The filter feature obtains a list of log entries based on some filtering criteria. (Col. 11, lines 2-11)

Erickson, on the other hand, teaches document classes and product classes (col. 7, lines 14-17; col. 7, lines 50-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made the system, method and software of Morscheck, to include global content directory which includes a plurality of classes; documents comprise unique documents stored in seller database; classes comprise a plurality of document classes; the classes comprise a plurality of product classes, as taught by Erickson, in order to allow easy access to the information stored (Erickson, col. 7, lines 16-17).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARISSA THEIN whose telephone number is (571)272-6764. The examiner can normally be reached on M-F 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot  
November 7, 2008

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627